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OCT 11 2007

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|---------------------------------|---|----------------------------|
| In re Application of | : | OFFICE OF PETITIONS |
| Rix S. Chan et al. | : | |
| Application No. 09/216,378 | : | DECISION ON PETITION |
| Filed: December 18, 1998 | : | UNDER 37 C.F.R. § 1.181 |
| Attorney Docket No.: 450.250US1 | : | |
| Title: NOISE REDUCTION SCHEME | : | |
| FOR A COMPUTER SYSTEM | : | |

This is a decision on the petition filed on July 11, 2007, pursuant to 37 C.F.R. § 1.181, requesting that the holding of abandonment in the above-identified application be withdrawn.

BACKGROUND

The above-identified application became abandoned for failure to reply within the meaning of 37 C.F.R. § 1.113 in a timely manner to the final Office action mailed July 13, 2006, which set a shortened statutory period for reply of three months. No extensions of time under the provisions of 37 C.F.R. § 1.136(a) were obtained, and no response was received. Accordingly, the above-identified application became abandoned on October 14, 2006.

RELEVANT PORTION OF THE C.F.R.

37 C.F.R. § 1.8(b) sets forth, *in toto*:

(b) In the event that correspondence is considered timely filed by being mailed or transmitted in accordance with paragraph (a) of this section, but not received in the U.S. Patent and Trademark Office after a reasonable amount of time has elapsed from the time of mailing or transmitting of the correspondence, or after the application is held to be abandoned, or after the proceeding is dismissed, terminated, or decided with prejudice,

the correspondence will be considered timely if the party who forwarded such correspondence:

(1) Informs the Office of the previous mailing or transmission of the correspondence promptly after becoming aware that the Office has no evidence of receipt of the correspondence;

(2) Supplies an additional copy of the previously mailed or transmitted correspondence and certificate; and

(3) Includes a statement which attests on a personal knowledge basis or to the satisfaction of the Director to the previous timely mailing or transmission. If the correspondence was sent by facsimile transmission, a copy of the sending unit's report confirming transmission may be used to support this statement.

ANALYSIS

With the present petition, Petitioner has asserted that a response was timely submitted via facsimile transmission on September 13, 2006. Petitioner has submitted a copy of this submission, and it is noted that it contains a certificate of facsimile transmission dated September 13, 2006. Petitioner has further provided a statement from the individual who executed this certificate of facsimile transmission.

Certificate of facsimile transmission practice provides a mechanism by which Applicants may evince that a paper was timely submitted to the Office, in the event that the correspondence is not received.

Petitioner's submission has been reviewed: with the present petition, Petitioner has informed the Office of the previous facsimile transmission, provided an additional copy of the previously submitted correspondence, and has included a statement which attests on a personal knowledge basis or to the satisfaction of the Director to the previous timely transmission.

Petitioner has requested that the holding of abandonment in the above-identified application be withdrawn. It is clear that a response was timely submitted. Considering the facts and circumstances of the delay at issue, as set forth on petition, it is concluded that Petitioner has met his burden of establishing that a submission was timely submitted. **However, the submission has been reviewed by the Examiner and it has not been deemed to place this application in condition for allowance.** A copy of the advisory action has been included with this decision.

It is clear from rules 37 C.F.R. §§ 1.116 and 1.135 that abandonment of an application is risked when the applicant

proffers an amendment after the mailing of a final Office action. The rule clearly indicates that the mere filing of an amendment does not relieve applicant of the duty to take appropriate action to save the application from abandonment.

If steps are not taken after final to maintain pendency prior to the expiration of the maximum extendable period for reply, the application will go abandoned. Put another way, the submission of an after final amendment which fails to place the application in condition for allowance will result in the abandonment of the application, unless one of the following four items is filed prior to the maximum extendable period for reply:

- a subsequent amendment which places the application in condition for allowance;
- a Notice of Appeal;
- a Request for a Continuation Application pursuant to 37 C.F.R. § 1.53(b), if applicable;
- a Request for Continued Examination pursuant to 37 C.F.R. § 1.114, or;
- a Terminal Disclaimer, if applicable.

It does not appear that any of these items was submitted prior to the expiration of the maximum extendable period for reply to the final Office action.

As such, the petition must be **DISMISSED**.

Any reply to this decision must be submitted within **TWO MONTHS** from the mail date of this decision. Extensions of time under 37 C.F.R. § 1.136(a) are permitted.

The reply should include a cover letter entitled "Renewed Petition Under 37 C.F.R. § 1.181(a)." This is not a final agency action within the meaning of 5 U.S.C § 704.

Alternatively, Petitioner may wish to consider filing a petition under 37 C.F.R. §§ 1.137(a) and/or (b).

Any future submission concerning this matter should indicate in a prominent manner that the attorney handling this matter is Paul Shanowski, and may be submitted by mail¹, hand-delivery², or facsimile³.

1 Mail Stop Petition, Commissioner for Patents, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA, 22313-1450.

It is noted that the address listed on the petition differs from the address of record. The application file does not indicate a change of correspondence address has been filed in this case, although the address given on the petition differs from the address of record. If Petitioner desires to receive future correspondence regarding this application, the change of correspondence address must be submitted. A courtesy copy of this decision will be mailed to Petitioner. However, all future correspondence will be directed to the address of record until such time as appropriate instructions are received to the contrary. Petitioner will not receive future correspondence related to this application unless Change of Correspondence Address, Patent Form (PTO/SB/122) is submitted for the above-identified application. For Petitioner's convenience, a blank Change of Correspondence Address, Patent Form (PTO/SB/122), may be found at <http://www.uspto.gov/web/forms/sb0122.pdf>.

Telephone inquiries regarding *this decision* should be directed to the undersigned at (571) 272-3225⁴. All other inquiries concerning examination procedures or status of the application should be directed to the Technology Center.



Paul Shanoski
Senior Attorney
Office of Petitions
United States Patent and Trademark Office

Encl. Advisory Action

cc: WOODS FULLER SHULTZ & SMITH P.C.
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2 Customer Window, Randolph Building, 401 Dulaney Street, Alexandria, VA, 22314.

3 (571) 273-8300- please note this is a central facsimile number.

4 Petitioner will note that all practice before the Office should be in writing, and the action of the Office will be based exclusively on the written record in the Office. See 37 C.F.R. § 1.2. As such, Petitioner is reminded that no telephone discussion may be controlling or considered authority for Petitioner's further action(s).

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/216,378

Applicant(s)

CHAN ET AL.

Examiner

Lun-See Lao

Art Unit

2615

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 11 July 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: _____.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

Continuation of 11. does NOT place the application in condition for allowance because Applicant's arguments are not persuasive. Note the final Office action for the examiner's position. Further, regarding the argument that the final Office action conceded that Lambrecht does not actually teach the built-in microphone (Remarks, page 10), the examiner's position appeared mischaracterized. As discussed in the rejection of claim 1, while Lambrecht does not explicitly teach that the microphone is of a built-in type, Lambrecht teaches the microphone is physically located with the speaker, and the speaker in turn is a conventional speaker (col. 3, lines 48-53). One of ordinary skill in the art would realize that for the PC (notebook computer 154) as shown in figure 1, the speaker would be built into the PC / notebook computer. In other words, the microphone would be built into the PC / notebook computer, to be physically located with the speaker. It is noted that it was what Lambrecht suggests to one of ordinary skill in the art, rather than the explicit teaching of Lambrecht, that was relied upon to show that Lambrecht meets the claimed limitation. Applicant cited Summary of the Invention of Lambrecht (Remarks, pages 11-12). However, Lambrecht clearly stated in the Summary that "[t]he audio signal is output to the listener via a speaker or headphone to accomplish the noise cancellation". In other words, it is the calculation of the software application and the generation of the cancellation signal that provides the cancellation functionality, rather than the locations of the speaker or the microphone. As to the argument that the Lambrecht system, as modified, cannot generate "sufficient volume in free air to overcome the noise", it is noted that the claim language, for example, claim 1, does not require "sufficient volume in free air to overcome the noise". Instead, it only requires "... generates a noise cancellation signal responsive to the detected ambient noise" and "for provision to... to reduce headphone noise". No strength of the noise cancellation signal is claimed. Applicant's argument that McIntosh does not teach detecting ambient noise but the noise that actually penetrates the earcup (rather than sounds that do not enter the earcup) (Remarks, pages 14-16). The examiner's position is that the noise that actually penetrates the earcup (rather than sounds that do not enter the earcup) is the actual ambient noise presented to, and sensed by, a listener because this is almost the only way that any ambient noise is sensed by a listener. Applicant appears to argue that applicant's ambient noise does not include the ambient noise ears that penetrates the earcup. However, such distinction is not claimed. See, for example, claim 1. Regarding applicant's argument that McIntosh does not teach a standard headphone compatible audio output connection (Remarks, pages 17-18), the examiner's position is that the claim language, see, for example, claims 1, 8, 13, 16 and 24, requires audio output connection to be compatible with a standard headphone, which is met by Lambrecht who teaches the output port to the user's headphone, which is certainly compatible with any standard headphone. Whether the headphone connection includes an input, or bidirectional communication, is clearly not recited in the claims. See, for example, claims 1, 8, 13, 16 and 24. For these reasons, applicant's arguments are not persuasive.